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EXAMINER
WORJLOH, JALATEE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte REID F. HAYHOW

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Appeal 2009-012653
Application 10/684,281
Technology Center 3600

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Decided: Mach 8, 2010

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Before JOSPH A. FISCHETTI, BIBHU R. MOHANTY, and
KEVIN F. TURNER, *Administrative Patent Judges.*

TURNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Final

Rejection of claims 14-25. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.[1]

THE INVENTION

Appellant's claimed invention relates to a system for testing a device

communicatively connected to a tester. The tests are performed based on

logic which enables one or more tests and creates a log. (Spec. 3-4).

Independent claim 14, which is deemed to be representative, reads as

follows:

> 14. A system comprising:
> a tester to apply one or more tests to a device; and
> logic, communicatively coupled to the tester, to
> enable one or more resources of the tester according to
> one or more properties of an electronic license and to
> create at least one log file having resource use
> information for one or more tests executed on the tester.

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on
appeal is:

Organ et al.   7,191,368 B1   Mar. 13, 2007

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[1] Our decision will make reference to the Appellant's Appeal Brief ("App.
Br.," filed Mar. 9, 2009) and Reply Brief ("Reply Br.," filed Jun. 22, 2009),
and the Examiner's Answer ("Ans.," mailed Apr. 14, 2009).

The Examiner rejected claims 14-25 under 35 U.S.C. § 102(e) as being anticipated by Organ.

ISSUES

Appellant argues that Organ fails to disclose logic to enable one or more resources of the tester according to one or more properties of an electronic license. (App. Br. 8-9). Additionally, Appellant argues Organ fails to disclose logic to create a log file having resource use information. (App. Br. 11). The Examiner finds that Organ is capable of checking rules (Ans. 5) and discloses at least one log file having resource use information. (Ans. 3).

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Thus, the issues arising from the respective positions of Appellant and the Examiner are:

Has Appellant shown that Organ fails to disclose logic to enable one or more resources of the tester according to one or more properties of an electronic license, as recited in the independent claim 14?

Has Appellant shown that Organ fails to disclose logic to create a log file having resource use information, as recited in the independent claim 14?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by at least a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

Claim Interpretation

1. Appellant's Specification describes that "logic" may be part of an operating system or part of the firmware. (p. 3, ¶ [0010]).

2. The ordinary and customary meaning of "logic" in the context of computer science is "a. [t]he nonarithmetic operations performed by a computer, such as sorting, comparing, and matching, that involve yes-no decisions."[2]

3. The Examiner found that "logic" was equivalent to a program. (Ans. 6).

4. Appellant's Specification describes that logic may be used to enable the tester according to one or more properties associated with an electronic license. (p. 3, ¶ [0011]).

Organ

5. Organ is directed to an electronic tester with digital, analog, and memory test circuitry. (Abs.).

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[2] *Logic Definition*, The American Heritage® Dictionary of the English Language,4th ed., http://dictionary.reference.com/browse/logic (last visited Mar 2, 2010).

6. Organ describes that its tester is coupled to a device under test which can be a system-on-a-chip (SOC) integrated circuit. (Abs.).

7. Organ describes that when a program is loaded, tester resource allocation and rules checking is performed. (col. 12, ll. 4-6).

8. Organ describes a data log which records measurements made during the device testing. (col. 14, ll. 46-49).

PRINCIPLES OF LAW

Anticipation

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). Under the principles of inherency, a reference anticipates if it necessarily includes or functions in accordance with the claimed limitations. *Atlas Powder*, 190 F.3d at 1347. Inherency may be established by extrinsic evidence, but "[s]uch evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities, and "[t]he mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Id. at 1269*.

It is well established that while the features of an apparatus claim may be recited functionally, the apparatus must be distinguished from the prior

art in terms of structure, rather than function. *See In re Schreiber*, 128 F.3d
1473, 1477 (Fed. Cir. 1997).

ANALYSIS

Claims 14-25 rejected under 35 U.S.C. § 102(e) as being anticipated by
Organ.

Claim 14

Appellant argues that Organ fails to disclose logic to enable one or
more resources of the tester according to one or more properties of an
electronic license. (App. Br. 8-9). We are not persuaded by Appellant's
argument and agree with the Examiner that Organ's electronic tester
discloses rules which are processed when its program is loaded. (FF 5, 7).
We find that these rules are equivalent to the one or more properties of the
electronic license, but not necessarily the electronic license *per se*. Since
logic enables Appellant's tester according to the one more properties
associated with the electronic license, it is these properties that enable the
resources of the tester, rather than the electronic license itself. While
Appellant is correct that nothing in Organ implies that rules checking
includes license checking, (App. Br. 8), we do not find claim 14 to have
such a requirement. Accordingly, the rules in Organ are capable of enabling
the program (i.e., logic) to allocate the resources of the tester and thus do not
distinguish the claimed system from the prior art. (FF 1, 2, 3, 4). Therefore,
Appellant's argument is not persuasive as to error in the rejection.

Additionally, Appellant argues Organ fails to disclose logic to create a
log file having resource use information. (App. Br. 11). We are not

persuaded by Appellant's argument and find that Organ discloses a data log which records measurements made while testing a device. (FF 8). Thus, the system of Organ is capable of creating a log file having resource use information for the test performed by the tester, as recited by Appellant's claim 14. Therefore, Appellant's argument is not persuasive as to error in the rejection.

Dependent claims 15-25

Appellant does not separately argue claims 15-25 which depend from claim 14, and so has not shown that the Examiner erred in rejecting claims 15-25 under 35 U.S.C. § 102(e) as anticipated by Organ for the same reasons we found as to claims 14, *supra*.

CONCLUSION OF LAW

We conclude that the Appellant has not shown that Organ fails to disclose logic to enable one or more resources of the tester according to one or more properties of an electronic license, as recited in the independent claim 14.

We conclude that the Appellant has not shown that Organ fails to disclose logic to create a log file having resource use information, as recited in the independent claim 14.

DECISION

The decision of the Examiner to reject claims 14-25 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

<u>AFFIRMED</u>

ack

cc:

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